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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/560,370

12/13/2005

Akihiro Nakamura

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08/01/2008

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EXAMINER

PENG, KUO LIANG

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

08/01/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/560,370	Applicant(s) NAKAMURA, AKIHIRO	
	Examiner Kuo-Liang Peng	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/20/08 Response/Amendment.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6 and 8 is/are rejected.
- 7) ☒ Claim(s) 7-12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/13/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's election without traverse of the invention of Group I in the response to restriction requirement filed June 20, 2008 is acknowledged.
2. In view of the amendment filed concurrently with the response to the restriction requirement, now, Claims 1-2 and 4-12 are pending.

Claim Rejections - 35 USC § 112

3. Claim 8 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Examiner is not able to find a basis of utilizing an organopolysiloxane in the claimed amount. Applicants are reminded that the specification discloses that component C) (**as a whole**) contains an aromatic amine compound and/or an organopolysiloxane containing aromatic amine groups in an amount of 0.001 to 10 parts by weight for each 100 parts by weight of component A). (Emphasis added) In other words, when both the aromatic amine compound and the organopolysiloxane containing aromatic amine groups are used as component C),

the **combined amounts thereof** should be 0.001 to 10 parts by weight for each 100 parts by weight of component A).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1 and 4-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Enami (EP 771 862).

Enami discloses an adhesive tape containing a **support film** and a **pressure sensitive adhesive** deposited thereon where the pressure sensitive adhesive comprises A) a **reaction product** of a) a rubber-like polydiorganosiloxane containing both alkenyl and hydroxyl groups and b) a hydroxyl or alkoxy group-containing MQ resin, B) a hydrogen atom-containing polydiorganosiloxane, and C) a **platinum catalyst**. (page 2, line 39 to page 3, line 4, page 5, lines 32-38 and Examples) The molar ratio of **Si-H to Si-alkenyl** and that of **M unit to Q unit** are described in page 3, lines 25-44 and page 5, lines 4-8. An amine (e.g.,

benzylamine) is further employed for facilitating the reaction between ingredients a) and b) in an amount illustrated in page 3, line 47 to page 4, line 7. The adhesive can optionally contain **unreacted** ingredients a) and b) and/or a **solvent**. (page 3, lines 27-29 and page 5, lines 20-31) A **curing reaction adjustor** can also be used. (page 5, lines 20-31)

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-2 and 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murakami (US 4 774 297) in view of Konings (US 5 371 162).

Murakami discloses an adhesive tape containing a **support film** and a **pressure sensitive adhesive** deposited thereon where the pressure sensitive adhesive comprises A) an **alkenyl-containing silicone gum**, B) an **MQ resin** with specific **M/Q molar ratio**, C) an **organohydrogenpolysiloxane**, D) a **platinum**

catalyst, a **solvent** and optionally an **addition-reaction inhibitor**. (col. 1, line 57 to col. 4, line 20, col. 4, lines 11-20 and 26-33 and Examples) The molar ratio of **Si-H to Si-alkenyl** is described in col. 3, lines 50-52. Murakami further teaches that the presence of a **stabilizer** is desirable. (col. 4, lines 21-25) Murakami is silent on a specific stabilizer to be used. However, Konings teaches, in an **addition-curable adhesive** composition, a **stabilizer** represented by formula (F11) that can be a **primary** or a **secondary** amine where R can be an aryl group exemplified as a **phenyl** group. (col. 1, lines 5-12, col. 4, lines 15-21 and col. 10, lines 22-52) The amount of the amine is demonstrated in Examples. The motivation of the employment of the amine is to afford a composition with sufficient stability upon exposure to elevated temperatures. (col. 11, line 67 to col. 12, line 16) In light of the benefit, it would have been obvious at the time the invention was made to incorporate Konings' amine as a stabilizer into Murakami's adhesive with expected success.

8. Claims 7 and 9-12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

None of the above references, taken alone or in combination, teaches or fairly suggest the use of the claimed polysiloxane containing aromatic amine group.

9. Claim 8 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, first paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

None of the above references, taken alone or in combination, teaches or fairly suggest the use of the claimed polysiloxane containing aromatic amine group.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck, can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp
July 30, 2008

/Kuo-Liang Peng/
Primary Examiner, Art Unit 1796